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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,537	03/12/2002	Udo Skerdi	P-1105	4019

7590 07/01/2003

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EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

10/009,537

Applicant(s)

SKERDI, UDO

Examiner

Edward A. Miller

Art Unit

3641

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The reply filed on December 15, 2000 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

The reply is partly not responsive for a number of reasons as follows.

In the first instance, applicants were required in paragraph 5 of Paper No. 7 to disclose the earliest publication of their invention. Applicants did discuss the origin of the instant PCT national stage application, but failed to state what was the earliest date of publication of their invention. This is non-responsive. This is information that applicants uniquely know. A PCT application with search report is ordinarily published at an early time; however, the Office does not know what the earliest date of publication is, which may relate to if the invention may have been published in a journal, where the application was filed and the various, relevant national laws (as well as PCT rules). Applicants' reply, to be complete, must include this information. A rejection might lie based on the facts of this case, under such law as *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958).

Secondly, applicants' reply as to the required substitute specification is improper and inconsistent. Applicants state in their reply, that the first document (A) is a "true and complete translation." Applicants also state that the second document (B) "merely corrects translation errors." Applicants also affirmatively state that document (C), a clean copy, "includes no new matter." These statements are inconsistent. If the original was "true and complete," there can be no translation errors. Two different things cannot both be true and complete. This does not relate to such formal matters as insertion of heading such as "Background," "Prior Art," and so forth. There appear to be a number of material changes. In one such change, on the first page, the word "materials" is inserted twice in the same line. This appears to be a material change. This is only at first blush, the specification has not been exhaustively reviewed at this time. Applicants are also advised that a statement of no new matter is made under the duty of candor.

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As to the specification, the version of the specification as accepted by the USPTO, was that version received and date stamped on 12 March 2002. One version was received on 30 November, 2001. However, this version, which contained a certificate of translation, contained numerous changes to the typed document, made in blue pen, which changes were not dated and which lacked initials. Who made these changes? When were they made? There is no indication that the initialed changes were made by the translator, prior to the execution of the certificate of translation.

Compare MPEP 605.04(a), including:

The oath or declaration requirements for an international application before the Patent and Trademark Office are set forth in 35 U.S.C. 371(c)(4) and 37 CFR 1.497. 37 CFR 1.52(c)(1) states that “[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed must be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.” 37 CFR 1.52(c)(2) states that after the signing of the oath or declaration referring to the application papers, amendments may only be made in the manner provided by 37 CFR 1.121.

Subsequently, applicants filed the version that was accepted, received 12 March 2002, as above.

Applicants are required to confirm whether the version that was first filed on 12 March 2002, was the version which applicants’ translator certified as a “true and correct” translation.

Next, applicants are required to cite any authorities (US case law) known that relate to the question of correction of an error in translation of an national stage PCT application. This appears to relate to new matter, MPEP 2163, including:

While there is no in *haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of the error in the specification, but also recognize the appropriate correction. *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

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Applicants are further required to justify, point out the basis for, each change <sup>to</sup> in the original <sup>and claims</sup> specification (received 12 March 2002) that relates to modifications in the language, as opposed to, e.g., section headings. In the national stage, applicants are required to abide by the national law of the US as regards matters affecting patentability. PCT Article 27, section (5). Sam  
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See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
June 27, 2003



EDWARD A. MILLER  
PRIMARY EXAMINER